

Applicants submit the Declaration of Hikoshiro Nishimura ("the Nishimura Declaration") relating to the commercial success of the claimed invention and the Declaration of Hiroyushi Yamamoto ("the Yamamoto Declaration") relating to the non-obviousness of the claimed invention.

### REMARKS

#### Commercial Success

Applicants submit the Nishimura Declaration as evidence on the secondary considerations/objective considerations concerning non-obviousness. This evidence is entitled to careful consideration. *In re Sermaker*, 702 F.2d 989, \_\_\_, 217 U.S.P.Q. 1, 7 (Fed. Cir. 1983) ("If...a patent application properly presents evidence relating to these secondary considerations, ... [the Patent and trademark Office Board of Appeals] must always consider such evidence in connection with the determination of obviousness.") *Minnesota Mining and Manufacturing v. Johnson & Johnson*, 976 F. 2d 1559, 1573, 24 U.S.P.Q. 2d 1321, 1333 (Fed.Cir. 1992) ("...objective evidence such as commercial success... must be considered before a conclusion on obviousness is reached... Indeed, as then Chief Judge Markey said in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F. 2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983), "evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art is not.")

The Nishimura Declaration establishes the commercial success of the claimed invention in the present application in that almost 75 million writing instruments having ink of the present invention were sold with a sales volume in excess of \$22 million dollars<sup>1</sup> from October, 2000 to June, 2002. Of this, sales in the United States was almost fourteen million writing instruments at

<sup>1</sup> At an exchange rate of 122 Japanese Yen to the U.S. Dollar.

a sales volume of almost nine million dollars. In 2001, writing instruments using the present invention accounted for 50% of the relevant sales of gel-type, ball-point pens using pigment as coloring materials by the assignee of the present invention.

Specifically,

1. The assignee of the present application, Sakura Color Products Corporation ("Sakura"), manufactures and sells ball-point pen writing instruments having an ink container in which an aqueous glittering ink is packed, wherein the aqueous glittering ink composition comprises a glass flake pigment coated with a metal and having a median diameter of about 5 to about 100  $\mu\text{m}$ , a water-soluble resin, a water-soluble organic solvent and water. (Nishimura Declaration, paragraph 3.)

2. These writing instruments are sold under the trademark "TIARA" in Japan and under the trademark "GELLY ROLL STARDUST" outside Japan. A true copy of a catalog of "TIARA" writing instruments is attached as Exhibit A to the Nishimura Declaration. A true copy of a catalog of "GELLY ROLL STARDUST" writing instruments is attached as Exhibit B to the Nishimura Declaration. (Nishimura Declaration, paragraph 4.)

3. The worldwide sales of writing instruments that use the ink composition identified in paragraph 1 are as follows:

WORLDWIDE SALES*		2000**	2001**	2002**
Number of pens sold	Total	24,361,000	38,571,000	11,323,000
	Japan	12,996,000	16,049,000	3,648,000
	Overseas	11,365,000	22,523,000	7,675,000
Sales amount	Of overseas, USA	(5,000)	(11,185,000)	(3,665,000)
	Sales in Japan only (Yen)	650,000,000	802,000,000	182,000,000
	Sales in U.S. only (Dollar)	3,000	6,655,000	2,181,000

\*Sales by Sakura and its affiliates

\*\*Each year represents October to September (with an exception of year 2002, which represents October to June)  
(Nishimura Declaration, paragraph 5.)

[The entries in the fifth row ("Of overseas, USA") are actually positive numbers.]

4. The amount of money spent worldwide on advertising and promoting the writing instruments identified in Paragraph 1 is the same as that for other writing instruments in their first two years of sale. (Nishimura Declaration, paragraph 6.)

5. The writing instruments identified in Paragraph 1 were the following percentage of the sales of all gel-type ink, ball-point pens that used pigment as a coloring material that were sold by Sakura.

2000	2001	2002
15%	50%	Not available

(Nishimura Declaration, paragraph 7.)

The claimed invention of the present application is commercially successful.

### Non-Obviousness

Applicants submit the Yamamoto Declaration as evidence of the non-obviousness of the claimed invention of the present application.

The Yamamoto Declaration establishes that one of ordinary skill in the art, as of March 19, 1999 (the filing date of the earliest Japanese priority application), would have known that an ink must flow through the writing instrument in such a way as to form a satisfactory mark, a mark that is legible and uniform, without clogging or wearing the writing tool, that glass flake particles were flat and had sharp edges, and that these characteristics would teach against using glass flake pigment.

Specifically,

1. The field of technical art that relates to the claims of the present patent application is the formulation of ink compositions for writing instruments and the design of writing instruments for ink compositions. (Yamamoto Declaration, paragraph 3.)

2. As of the time of filing Japanese Patent Application No. 11-076868 on March 19, 1999, a person of ordinary skill in the art relevant to the claims of the present patent application would not have considered those claims as obvious in view of the disclosure of U.S. Patent No. 3,053,683 to Yolles whether taken alone or in combination with other information. (Yamamoto Declaration, paragraph 5.)

3. As of the time of March 19, 1999, a person of ordinary skill in the art relevant to the claims of the above identified U.S. patent application would not have considered the disclosure of U.S. Patent No. 3,053,683 to Yolles as a source of information for a glittering material for an aqueous glittering ink composition or a writing tool having an ink container in which an aqueous glittering ink composition is packed or a method for using an aqueous glittering ink composition for a writing tool. (Yamamoto Declaration, paragraph 6.)

4. As of the time of March 19, 1999, when a person of ordinary skill in this art considered the problem of how to make a written mark that glittered, that person would have in mind the technical specifications of how a writing instrument makes a written mark with an ink. That is, the person would know that an ink must flow through the writing tool in such a way as to form a satisfactory mark, a mark that is legible and uniform, without clogging or wearing the writing tool. (Yamamoto Declaration, paragraph 7.)

5. As of the time of March 19, 1999, therefore, with this background knowledge of the requirements for forming a satisfactory mark with a writing tool in mind, one of ordinary skill in the art of formulating writing inks and designing writing tools would not look to glass flake particles as a possible glittering material because that person would know that glass flake particles were flat and had sharp edges and that these characteristics would teach against using glass flake pigment as a glittering material in the art of formulating writing inks and designing writing tools. (Yamamoto Declaration, paragraph 8.)

Consequently, as of the filing date of the earliest Japanese priority application of the present application, a person of ordinary skill in the art would not have considered the disclosure of the Yolles patent as a source of information nor would they have considered the claimed

invention of the present application obvious in view of the disclosure of the Yolles patent, whether alone or in combination.

CONCLUSION

In view of the foregoing remarks, Applicants submit that the pending claims are in condition for allowance and such action is requested.

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Respectfully submitted,

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